

### REMARKS

The present amendment is in response to the Office Action dated January 26, 2010. Claims 29-33, 36-45, 47-50, 52-58, 67, and 69-76 are now present in this case. Claim 75 is currently amended.

The applicant kindly thanks the Examiner for the telephone interview with the applicant's attorney on March 24, 2010. As discussed in that interview, the applicant believes that Mayaud does not teach or suggest joint optimization of parameters because price data is presented before drug selection by the physician. There is no automatic cost optimization because the physician must manually select a drug and may, or may not, make that selection on the basis of cost. Thus, the "system" does not automatically optimize based on economic parameters. Similarly, the system of Mayaud does not teach or suggest the presentation of records that are automatically jointly optimized based on economic parameters and statistical risk. The drug allergy analysis, which the Examiner believes is analogous to statistical risk, is performed only after manual drug selection by the physician. Thus, it is impossible for Mayaud to automatically jointly optimize data based on determined economic parameters and statistical risk.

The applicant respectfully notes that the Office Action contains a number of errors as to claim status and contains rejections of claims that had previously been canceled. Specifically, the Office Action Summary states that claims 29-33, 35-50, 52-59, 61-66, and 74-76 are pending in the application. This is incorrect. Claims 29-33, 36-45, 47-50, 52-58, 67, and 69-76 are currently pending in this application. The Detailed Action at the top of page 2, also includes errors in claim disposition. The Office Action states that claims 29-33, 36-45, 47-50, 52-58, 67, and 69-74 were previously amended. This is incorrect. Claims 29-32, 37, 38, 44, 45, 47-50, 52-54, 67, and 69-76 have been amended. Claims 33, 36, 39-43, and 55-58 are presented in their original form. The Detailed Action further states that claims 75-76 were added. These claims were not added in the previous amendment filed November 10, 2009, but were added in a prior amendment filed July 9, 2009. Thus, claims 75-76 should be designated as "previously presented."

The Office Action includes an informalities objection because the status of claims 1-28, which had been canceled, was not mentioned in the November 10, 2009 Amendment filed in this matter. This informality has been corrected and applicant respectfully requests the withdrawal of this objection.

Claim 76 is rejected under 35 U.S.C. § 112, second paragraph. The applicant respectfully traverses the rejection and requests reconsideration. The Office Action dated August 14, 2009 contained a rejection of claim 76 and referred to a word that precedes the word “means.” Following a telephone conference with the Examiner on October 30, 2009, the applicant was under the mistaken impression that the word “input,” which is the only word that precedes “means” in claim 76 was the source of the Examiner’s objection. Per the Examiner’s recommendation, claim 76 was amended to remove the word “input.” The current Office Action still refers to words that precede the word “means” in maintaining the rejection of claim 76. The applicant respectfully requests clarification. The Office Action states that “since no function is specified by the word(s) preceding “means,” it is impossible to determine the equivalence of the element.” Claim 76 contains no words preceding the word “means” in any of the claim elements. MPEP § 706.03(d) contains sample paragraphs to use in a rejection under 35 U.S.C. § 112, second paragraph. Example paragraph 7.34.11 includes the precise language used in the Office Action in the rejection of claim 76. However, this is a completely inappropriate rejection as there are no words preceding the word “means” in claim 76. The Examiner has used this stock paragraph and used the word “for,” which follows the word “means” and does not precede the word “means.” Therefore, the applicant respectfully requests the withdrawal of the rejection of claim 76 under 35 U.S.C. § 112, second paragraph.

Claims 29-33, 35-50, and 74-76 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,845,255 to Mayaud. At the outset, it should be noted that this rejection includes a number of claims that were previously canceled. Specifically, claims 35, 46, and 59-66 were previously canceled. Furthermore, the Office Action asserts at page 3 that claims 44, 45, 47-50, and 52-58 are rejected under 35 U.S.C. § 102(e) as anticipated by Mayaud. However, there is no discussion of these claims under an anticipation rejection. Instead, claims 44, 45, 47-50, and 52-58 appear

to be rejected under 35 U.S.C. § 103(a) over the combination of Mayaud and U.S. Patent No. 5,866,428 to Kim et al. While this is an incorrect rejection under 35 U.S.C. § 102, the applicant will treat the rejection of claims 44, 45, 47-50, and 52-58 as an obviousness rejection over the combination of Mayaud and Kim. Thus, the applicant will treat rejection under 35 U.S.C. § 102(e) as a rejection of claims 29-33, 36-43, and 74-76. The applicant respectfully requests confirmation of the appropriate claim rejections from the Examiner. Due to the uncertainty and claim rejections, a new, non-final Office Action may be warranted. The applicant respectfully traverses the rejection and requests reconsideration.

With respect to claim 29, the applicant previously argued that Mayaud does not determine “a statistical risk associated with a respective record” nor suggest the step of “presenting, on a computer output device, a subset of records automatically jointly optimized based on the determined economic parameters, and the statistical risk associated with the selected record.” The present Office Action maintains the rejection and, in a response to arguments at page 8 of the Office Action, the Examiner asserts that drug cost is an economic parameter as is a statistical risk (risk of allergy). The Office Action further asserts that “the system then makes a drug selection upon consideration of all the input parameters, not just one parameter. Thus, the optimization is jointly based upon all of the input parameters, not just one single parameter.” (Office Action, page 8, emphasis added). The Office Action mischaracterizes Mayaud, which is simply a prescription management system. The so-called joint optimization is, in fact, manual presentations of multiple different screens that require manual selection by the physician. With respect to “economic parameters,” the Office Action cites Mayaud at column 39, lines 45-54 which describes a screen display of drug pricing information. However, the Office Action appears to ignore the explicit language in that section that describes how “pricing information can greatly influence M.D. decision-making.” (Column 39, lines 51-52.) The price of drugs can be shown on the display screen, such as illustrated in Figure 7 of Mayaud and used by the physician to manually make a decision that may include cost as a factor. While the Office Action states, at page 8, that “the system” makes a drug selection, the drug selection in Mayaud is manually selected by the physician. This is clear at several points in Mayaud, including column

39, lines 50-51. Figure 18, also cited in the Office Action, includes the selection of a drug at step 121. Mayaud makes it clear that the physician selects the drug at step 121. “After a physician selects a drug block 121 from one of the screens of FIGS 7-10, the system can optionally scan a drug preference database.” (Column 39, lines 57-59). Thus, the “system” in Mayaud merely presents screens that allow the physician to manually select a drug in step 121. Price data may be included in the screens shown to the physician, but it is the physician that manually selects the drug and may, or may not, select a drug based on cost. Thus, there is no automatic optimization based on economic parameters as asserted by the Office Action on page 8.

The applicant had previously argued that Mayaud discloses manual drug selection by the physician and not some automated system. In response to that argument, on pages 8-9 of the Office Action, the Examiner asserts that Mayaud discloses such automatic selection at column 21, lines 22-64. This is incorrect. The cited section of Mayaud merely describes a flow chart in which a patient condition is selected from a list and the system generates a list of drugs “known to be therapeutically indicated for the condition.” (See column 35, lines 23-28). It is important to note that nothing in Mayaud suggests the “system” automatically selecting a drug based on optimization of economic and risk parameters. Mayaud is clear that at step 121, shown in the middle of Figure 18, the physician selects the drug. (See Figure 18 and column 39, line 57). chart of Figure 18 clearly shows that an allergy or drug interaction evaluation also occurs after the selection of the drug by the physician. Since price data records are presented before the manual selection of a drug by the physician and the allergy analysis is performed after the manual selection of a drug, it is impossible for Mayaud to teach presenting records “automatically jointly optimized based on the determined economic factors, and the statistical risk associated with the associated selected record,” as recited in claim 29. Simply put, the price data and allergy analysis are two separate, independent features of Mayaud that occur at different points in time. There is no joint optimization in Mayaud. Thus, Mayaud does not teach at least one element recited in claim 29. Accordingly, claim 29 is allowable over Mayaud. Claims 30-33, 36-43, and 74 are also allowable in view of the fact that they depend from claim 29, and further in view of the recitation in each of those claims.

Claim 75 is directed to an apparatus and recites *inter alia* a processor configured to “determine economic parameters for the set of records and optimize the set of records based on both the determined economic parameters and the determined statistical risk.” As discussed in detail above with respect to claims 29 and 44, Mayaud cannot be held to teach optimization of records based on both the determined economic parameters and the determined statistical risk. As noted above, Mayaud displays cost information, if any, before the physician selects a drug and displays allergy information after the physician selects a drug. (See Figure 18 of Mayaud). Because price information is used by the physician before selection of the drug and allergy information is considered after the selection of the drug, there is no way that Mayaud can be considered to “optimize a set of records based on both the determined economic parameters and the determined statistical risk,” as recited in claim 75. Accordingly, claim 75 is clearly allowable over Mayaud.

Claim 76 is a system claim, in means plus function format, and recites *inter alia* “means for presenting the set of records automatically optimized based on both the determined economic parameters and the determined statistical risk.” As discussed above, Mayaud displays price information before the selection of the drug by the physician and displays allergy information after the selection of the drug by the physician. Thus, Mayaud cannot possibly teach means for “presenting a set of records automatically optimized based on both the determined economic parameters and the determined statistical risk,” as recited in claim 76. Accordingly, claim 76 is allowable over Mayaud.

At page 3 of the Office Action, the Examiner asserts that claims 44, 45, 47-50, and 52-58 are rejected under 35 U.S.C. § 102(e) as anticipated by Mayaud. However, there is no detailed discussion of the rejection of those claims as anticipated by Mayaud. Instead, page 6 of the Office Action asserts that claims 44, 45, 47-50, and 52-58 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Mayaud and U.S. Patent No. 5,866,428 to Kim et al. The applicant respectfully requests clarification that these claims are not rejected under 35 U.S.C. § 102(e) as anticipated by Mayaud. The applicant respectfully traverses this rejection and requests reconsideration. The inapplicability of Mayaud has already been discussed in detail

above with respect to independent claims 29, 67, 75, and 76.

Independent claim 44 is directed to a method for presenting records to a user and recites *inter alia* “presenting the set of nutritional supplementation records automatically optimized based on both the determined economic parameters and the determined statistical risk.” As discussed in detail above with respect to claim 29, Mayaud presents a drug price list to allow the physician to use cost as a factor in the selection of a drug. Mayaud discloses the display of a drug price list, but does not teach or suggest any optimization based on prices. The physician manually selects the drug and may, or may not, use the price cost in the decision. There is nothing in Mayaud that suggests any “optimization” by the system. Furthermore, the price data is presented to the physician U the manual drug selection. However, the allergy/drug interaction considerations come into play only after the physician has selected a drug at step 121 (see Figure 18 of Mayaud). Because price information is presented manually to the physician before the drug selection and allergy drug interaction occurs after the drug selection, is impossible for Mayaud to teach “presenting a set of nutritional supplement records automatically optimized based on both the determined economic parameters and the determined statistical risk,” as recited in claim 44.

The Office Action cites Kim as “determining a set of records related to nutritional supplemental from an electronic database based on a classification of information therewithin and the user health parameter.” (See Office Action, page 6.) However, a complete reading of Kim shows that it is totally unrelated to any dietary supplementation. The brief section cited in the Office Action is the background section of Kim, which describes dietary deficiencies as a cause of anemia. However, the entirety of Kim is directed to techniques for determination of hemoglobin levels in blood. There is no electronic database of nutritional supplementation as alleged in the Office Action. The applicant respectfully requests that the Examiner point to a specific section of Kim where such an electronic nutritional supplementation database is disclosed. The mere mention of diet as a cause of iron deficiency is insufficient to establish Kim as teaching “determining a set of records related to nutritional supplemental from an electronic database,” as asserted in the Office Action. The combination of Mayaud and Kim does not teach or suggest “defining a set of records related to nutritional

supplementation from an electronic database” or “presenting the set of nutritional supplementation records automatically optimized based on both the determined economic parameters and the determined statistical risk,” as recited in claim 44. Thus, claim 44 is clearly allowable over the combination of Mayaud and Kim. Claims 45, 47-50, and 52-58 are also allowable in view of the fact that they depend from claim 44 and further in view of the recitations in each of those claims.

In view of the above amendments and remarks, reconsideration of the subject application and its allowance are kindly requested. The applicant has made a good faith effort to place all claims in condition for allowance. If questions remain regarding the present application, the Examiner is invited to contact the undersigned at (206) 757-8029.

Respectfully submitted,  
Andrew J. Szabo  
Davis Wright Tremaine LLP

/Michael J. Donohue, Reg. #35,859/  
Michael J. Donohue

MJD:mn

1201 Third Avenue  
Suite 2200  
Seattle, Washington 98101  
Phone: (206) 757-8039  
Fax: (206) 757-7029